

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appl. No. 10/733,843
Attorney Docket No.: Q78446

REMARKS

Claims 1-12 are all the claims pending in the Application. Claim 2 is editorially amended to cure a minor informality and claim 12 has been amended for reasons of precision of language and consistency. These amendments do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents.

Preliminary Matter

As a preliminary matter, the Examiner has accepted the replacement drawings filed on May 9, 2005.

Summary of the Office Action

Claims 1, 3-6, 8, and 12 presently stand rejected and claims 2, 7, and 9-12 contain allowable subject matter.

Claim Rejection under 35 U.S.C. § 112, second paragraph

Claim 12 is rejected under 35 U.S.C. § 112, second paragraph. Applicant respectfully thanks the Examiner for pointing out, with particularity, the aspects of the claim thought to be indefinite. Applicant respectfully requests the Examiner to withdraw this rejection in view of the self-explanatory claim amendment being made herein.

Allowable Subject Matter

Applicant thanks the Examiner for allowing claim 2. Claim 2 is amended to correct a minor informality.

Claims 7 and 9-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in their independent forms. Applicant respectfully holds the

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rewriting of these claims in abeyance until arguments presented with respect to the independent base claim have been reconsidered.

Prior Art Rejections

The Examiner maintained the rejections of claims 1, 3-6, and 8 under 35 U.S.C. § 102(b) as being anticipated by EP 0 384 128 to Winthrop (hereinafter "Winthrop"). Applicant respectfully traverses this rejection in view of the following comments.

Of these rejected claims, only claim 1 is independent. Independent claim 1, among a number of unique features, recites: "astigmatism peaks positioned at substantially same height or vertically higher than the far point." The Examiner alleges that claim 1 is directed to a progressive addition power lens and is anticipated by Winthrop.

In particular, the Examiner alleges that Winthrop inherently discloses astigmatism peaks being positioned at substantially the same height or vertically higher than the far point based on the fact that Winthrop discloses the maximum astigmatism being located above the 0-180° degree line of the lens (*see* page 6 of the Office Action). The Examiner further alleges that since Winthrop discloses the maximum astigmatism being located above the 0-180° degree line of the lens, this inherently discloses "astigmatism peaks positioned at substantially the same height as the far point or higher than the far point", as set forth in claim 1 (*see* page 6 of the Office Action). This grounds of rejection are technically inaccurate for at least the following reasons.

Since Winthrop only teaching having "the maximum astigmatism being located above the 0-180° degree line of the lens," the rejection is improper as it lacks "sufficient specificity" required under § 102. "[A]nticipation under § 102 can be found only when the reference

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discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account.” *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985); MPEP § 2131. Since above the 0-180° degree line only excludes the near region and not the intermediate corridor i.e., Winthrop discloses to place the maximum astigmatism only where it cannot interfere with the near-vision function, it lacks sufficient specificity required under § 102.

Moreover, under the doctrine of “inherency,” if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element “*is necessarily present in the thing described in the reference*” *Cont’l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). “Inherent anticipation requires that the missing descriptive material is ‘*necessarily present, not merely probably or possibly present*, in the prior art.” (emphasis added) *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 U.S.P.Q.2d 1597, 1599 (Fed. Cir. 2002); see also MPEP § 2112.

Winthrop discloses that maximum astigmatism of the occupational lens is even less than that of the general-purpose lens, 1.10 v. 1.51 diopters in a 2.00 add lens (page 12, lines 25 to 27). That is, for a reading addition of 2.00 diopters, the maximum astigmatism of the occupational lens is 1.10. With respect to the location of the maximum astigmatism of the occupational lens, Winthrop only teaches that it is located above the 0-180° line of the lens, where it cannot interfere with the near-vision function (Figs. 13A-C; page 12, lines 4 to 29). For example, as depicted in Fig. 13B, the maximum astigmatism of 1.00 is located above the near

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dioptric power region but in the intermediate corridor. That is, in Winthrop, there is no teaching or suggestion that astigmatism peak must be at a substantially same height or above the far point. Nothing in the teachings of Winthrop excludes placing the maximum astigmatism in the intermediate corridor below the far point, especially since Winthrop is only concerned with the near-vision function. In short, in Winthrop, the astigmatism peaks can be in the intermediate zone and not necessarily at a substantially same height or above the far point.

In summary, Winthrop reference does not teach or suggest the unique features of claim 1 and the Examiner has not met his burden in showing the inherent inclusion of the claim elements. In Winthrop, there is no teaching or suggestion that the astigmatism peaks must be at substantially same height or above the far point, as set forth in claim 1, and cannot be positioned in the intermediate corridor. Therefore, for all the above reasons, independent claim 1 patentably distinguishes from Winthrop. Claims 3-6 and 8 are patentable at least by virtue of their dependency on claim 1.

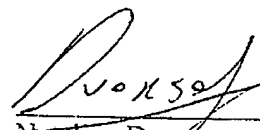
Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

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